

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Eran STEINBERG

Application No.: 09/823,920

Filed: March 29, 2001

For: VISUAL CELL PHONE
NOTIFICATION OF PROCESSED
FILM IMAGES

Mail Stop: AF

Expedited Procedures Requested

Group Art Unit: 2624

Examiner: Desire, Gregory M.

Confirmation No.: 7542

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request review of the final rejection of claims 1-2, 4-17, 21-23, 25-37, and 41 in the subject application. No amendments are being filed with this Request.

This Request is being filed with a Notice of Appeal.

Background

Claims 1-2, 4-17, 21-23, 25-37, and 41 are pending in the present application, of which claims 1, 21, and 41 are presented in independent form. Claims 1-2, 4-17, 21-23, 25-37, and 41 stand finally rejected.

Independent claims 1 and 21 stand rejected as being unpatentable over U.S. Patent No. 6,587,839 to McIntyre et al (hereinafter McIntyre), in view of U.S. Patent No. 6,701,302 to Schaeffer et al (hereinafter Schaeffer) and further in view of U.S. Patent

No. 6,587,596 to Haeberli (hereinafter Haeberli). The claims were finally rejected in a Second Final Office Action mailed December 19, 2005.

Applicant presented arguments regarding the improper combination of references made in the Second Final Office Action in Applicant's Amendment After Final transmitted on February 28, 2006. The arguments were deemed unpersuasive, with no further explanation, in an Advisory Action mailed April 13, 2006.

Reasons for Request

Applicant respectfully asserts that the record fails to establish a *prima facie* case for obviousness with respect to claims 1 and 21. Further, the Office has failed to address independent claim 41, thus leaving an inadequate record for appeal.

1. The Office has failed to establish a *prima facie* case of obviousness.

Applicant respectfully asserts the Office has failed to provide proper motivation for modifying McIntyre and Schaeffer with Haeberli as required by MPEP §706.02(j). MPEP §706.02(j) requires:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 1 and 21 stand rejected in view of McIntyre in view of Schaeffer and further in view of Haeberli. Applicant respectfully asserts that the Office has failed to provide a suggestion or motivation to combine the references as required by MPEP §706.02(j). Thus, the combination of these references is improper for the reasons discussed below. The Second Final Office Action briefly discusses (middle of page 4) a suggestion/motivation to combine as follows:

McIntyre, Schaeffer, and Haeberli are combinable because they disclose photographic prints. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include user adjustments to process print orders in the system of McIntyre and Schaeffer as disclosed by Haeberli. The suggestion/motivation for doing so would have been allowing [a] user more interaction when editing (note col. 3 lines 20-25).

The section of Haeberli cited by the Examiner (col. 3, lines 20-25) is directed to providing buttons for user interaction and states:

Optionally, the control can be a button that allows the user to change the shape of the selected portion of the image, a button that allows the user to zoom the selected portion of the image, or a button that allows the user to move the selected portion of the image.

Applicant respectfully disagrees with the contention that "allowing [a] user more interaction when editing" is a valid suggestion or motivation to combine Haeberli with McIntyre and Schaeffer. The Examiner admits that "McIntyre and Schaeffer do not clearly disclose users performing image adjustment and using image adjustments to process the print order." (Second Final Office Action, Page 4) It therefore follows, however, that allowing a user **"more interaction when editing"** does not provide the motivation needed to modify McIntyre and Schaeffer by adding user-specified image adjustments where there are no user-specified adjustments disclosed or suggested.

More particularly, the record fails to provide a motivation that would lead one of ordinary skill in this art to modify the combination of McIntyre and Schaeffer to include the user-specified image adjustments of claim 1, for example. The stated motivation is for more user interaction, which he supports with a description in Haeberli of buttons and their functions. What is lacking, however, is a stated motivation for user-specified image adjustments in the first place. Accordingly, Applicant asserts there is no motivation or suggestion to combine Haeberli with Schaeffer and McIntyre. More particularly, the disclosure in Haeberli of buttons that allow for more user interaction on a browser-based photo-editing system would not have motivated one of ordinary skill in

the art to combine Haeberli with the print order processing systems of Schaeffer or McIntyre.

Further, one of ordinary skill in this art would have had no motivation to combine Haeberli with either Schaeffer or McIntyre at least because Schaeffer and McIntyre aim to solve different problems than Haeberli. Haeberli is not subject to notifying a user that a print order is ready, which is the problem McIntyre was trying to solve. Further, neither McIntyre nor Schaeffer is directed to editing images, and particularly to user-specified image adjustments. Schaeffer and McIntyre are directed to systems for notifying consumers of ready print orders and for the distribution of images. It is unclear to applicant why one knowing McIntyre and Schaeffer would have been motivated to look to Haeberli for anything.

Accordingly, the failure to provide a motivation or suggestion for the combination of documents relied upon to support the obviousness rejection of claims 1 and 21, and the absence of a detailed response to Applicants arguments raised in the Second Final Office Action in Applicant's Amendment After Final (transmitted on February 28, 2006) regarding the improper combination of references, has resulted in a record that does not provide an appropriate basis to proceed with an appeal.

2. The Office has failed to address claim 41 leaving an inadequate record for appeal

As stated in Applicant's "Amendment After Final" dated February 28, 2006, the Office has failed to address claim 41. Claim 41 is not discussed in the Final Office Action mailed December 19, 2005 or in any other communication from the Office. Claim 41 is, however, listed as rejected on the Office Action Summary. 37 CFR 1.104 requires:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

This has not been done with respect to claim 41. Applicant can only make assumptions as to the references used to reject claim 41 as the Office has failed to address which references are pertinent to claim 41. As such, the record further fails to provide an adequate basis from which to proceed with an appeal with respect to claim 41. Should the same combination of references discussed above be used to reject claim 41, Applicant reiterates the above arguments regarding a lack of motivation or suggestion to combine the references.

Summary

As stated above, the record fails to establish a prima facie case for obviousness regarding claims 1 and 21. Further, the Office has failed to address claim 41. Accordingly, the rejection of independent claims 1, 21, and 41 should be withdrawn and the application should be passed to issue. Dependent claims 2, 4-17, 22-23, and 25-37 would be allowable for at least those same reasons.

Respectfully submitted,

Date: May 18, 2006

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